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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/551,656	04/18/00	MATSUO	<sup>mk</sup> T 43889-936

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IM22/1025

EXAMINER

HAMILTON, C

ART UNIT

PAPER NUMBER

1752

2

DATE MAILED:

10/25/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09-551,656

Applicant(s)

Matsuo et al

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 4-18-00
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-3 is/are pending in the application.
- Of the above claim(s) None is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-2 is/are rejected.
- ☒ Claim(s) 3 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The proposed drawing correction, filed on 4-18-00 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☒ received in Application No. (Series Code/Serial Number) 08805072
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). not given ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☒ Other Attachment

Office Action Summary

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Merrill et al (2,948,610) as evidenced by Winkle (5,650,261).

The polymers of Merrill wherein the acid from of the light sensitive alkali - soluble azide polymer is used anticipates the pattern forming material of instant claim 1 wherein the azide is a photobase generator as known is the and evidenced by Winkle in col. 10-11 with azides being shown as photobase generators in col. 11, lines 33-40. In Merrill et al, see particularly col. 1, lines 39-61, col. 4, lines 20-29, col. 6, lines 40-53.

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4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Potts et al (5,238,777) as evidenced by Winksle (5,650,261).

The polymers of Potts et al anticipate the compositions of instant claims 1-2 wherein carboxylic or sulphonic acid groups are the instant "second group having an acidic property" and the azide is the instant "first group for generating a base through irradiation". Winkler in col. 10-11 with azides being shown as photobase generators in col. 11, lines 33-40 evidences the inherent nature of azides to be this photobase generator. In Potts et al, since particularly Abstract, col. 1, lines 53-61, col. 2, lines 13-25, 60-68, col. 5, lines 3-7, claims.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tsuooka et al (Journal of Polymer Science) teach the instant photobase generator of applicants. Mertens (3,918,973) teach the same photobase generators but without polymeric linkage. Delzenne et al teach the same photobase generator structure in the main chain of polymers that photodegrade to allow solvent differences before and after irradiation.

6. The disclosure is objected to because of the following informalities: On page 31 (copy here attached) in the middle of the page is an oversparing saying "SIGH HERE" with an arrow and dots that obscures some of the words of the specification. A substitute page or appropriate amendment is required to remove this obvious informality. The examiner notes the original words are readable if the original page is held up to a bright light.

Appropriate correction is required.

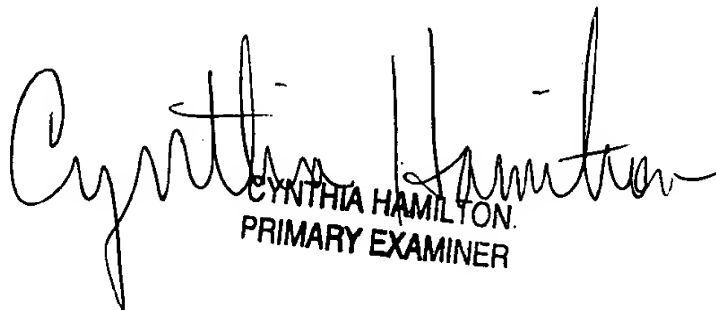
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7. Claim 3 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. U.S. Patent No. 5,714,628 was struck from the Information Disclosure Statement filed April 18, 2000 because the number did not match the inventor's name nor was a copy of the patent proffered or form in Parent applications as required under 37 CFR 1.98(a)(2). Matsuo et al (5,741,628) is cited by the examiner in the belief it is what was intended here.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is (703) 308-3626. The examiner can normally be reached on Monday - Friday from 9:30 am EST to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Janet Baxter, can be reached on (703) 308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599 for After Final responses or (703) 305-7718 for all other responses.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Cynthia Hamilton/om  
October 16, 2000

  
CYNTHIA HAMILTON  
PRIMARY EXAMINER